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Attorney's Docket No. 026350-048

Patent



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )  
Hiroshi SANO et al. ) Group Art Unit: 1638  
Application No.: 09/805,919 ) Examiner: Cynthia E. Collins  
Filed: March 15, 2001 )  
For: GENE WHICH EXHIBITS INDUCED )  
EXPRESSION BY STRESS )

**RESPONSE TO REQUIREMENT FOR RESTRICTION TRANSMITTAL LETTER**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (248) ☐ \$110.00 (148) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is \_\_\_\_\_
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$370.00 (279) ☐ \$740.00 (179) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted \_\_\_, on \_\_\_, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least \_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☐ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:

A M E N D E D C L A I M S					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (103) =	
Independent Claims		MINUS =		× \$84.00 (102) =	
If Amendment adds multiple dependent claims, add \$280.00 (104)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
<b>TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT</b>					


☐ A claim fee in the amount of \$\_\_\_\_\_ is enclosed.

☐ Charge \$\_\_\_\_\_ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
 Malcolm K. McGowan  
 Registration No. 39,300

P.O. Box 1404  
 Alexandria, Virginia 22313-1404  
 (703) 836-6620

Date: May 9, 2002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## In re Patent Application of

Hiroshi SANO et al.

Application No.: 09/805,919

Filed: March 15, 2001

For: **GENE WHICH EXHIBITS  
INDUCED EXPRESSION BY STRESS**

Group Art Unit: 1632

Examiner: Cynthia E. Collins

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**TECH CENTER 1600/2900**

## RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In complete response to the Official Action (Requirement For Restriction) mailed April 9, 2002, in regard to the subject application, Applicants respectfully elect Group III, i.e., claims 5-6, directed to a gene of SEQ ID NO:3, with traverse.

Restriction requirements are governed by 35 USC §121, which states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed. Independent claims are defined as having "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. . . ." MPEP § 802.01. Claimed inventions are "distinct" when the "are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (thought they may each be unpatentable because of the prior art)." *Id.* However, according to MPEP §803, "[i]f the search and examination of an entire application can be made without *serious burden*, the examiner must examine it on the

merits, even though it includes claims to independent or distinct inventions." (Emphasis added)

Applicants respectfully disagree with the Examiner in that Group II, directed to claims 3-4, and Group III, directed to claims 5-6, are distinct. Both of the nucleotide sequences of Groups II (SEQ ID NO:2) and Group III (SEQ ID NO:3) relate to C7 gene. Furthermore, the above-mentioned Groups differ only in that SEQ ID NO:3 defines cDNA of the C7 whereas SEQ ID NO:2 defines its open reading frame. Group I is drawn to a polypeptide of SEQ ID NO:1. The polypeptide of Group I is encoded by the SEQ ID NO:2. Groups II and III, as stated by the Examiner on page 2 of the Official Action, are classified under the same class and subclass. Based on the definitions disclosed above it is clear that in order to make a restriction an invention must have both distinct and independent parts. Group II and III of this invention are neither distinct nor independent, as they are connected in design, operation and effect. Therefore, Group II and Group III can be reasonably examined in the same application, under the same search area and without serious burden the Examiner. Additionally, Applicants believe that Group I is not distinct and independent from the invention relating to SEQ ID NO:2 and will not require seriously burdensome search.

The Examiner restricts inventions of claims 7 and 10-12 as purportedly being related as product and process of use. Group IV and VI are directed to a method rendering resistance to a plant against an environmental stress using the nucleotide sequences of Groups II and III. Therefore it can be shown that claims relating to these Groups are related and connected in operation and hence not independent from each other. Therefore,


for the reasons discussed above it is the Applicants' belief that a search inclusive of Groups II, III, IV and VI will not be seriously burdensome for the Examiner.

Groups V and VII are directed to a transgenic plant exhibiting resistance to an environmental stress and therefore are not distinct and independent from Groups I, II, III, IV and VI. Applicants maintain that it would not be an undue burden upon the Examiner to examine claims to several disorders at the present time.

From the foregoing, modification of the requirements for restriction, and examination of all of the claims of record on the merits, is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Malcolm K. McGowan  
Provisional Registration No. 39,300

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: May 9, 2002